



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Dayton, Ohio

Docket No. 7610.00

Application of

Kenneth A. Nicoll et al.

Serial No. 09/337,096

Filed: June 21, 1999

For: CASH TRANSACTION VERIFICATION AND CREDITING APPARATUS

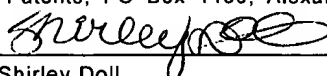
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Group Art Unit: 3624

Examiner: R. Weisberger

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Sir:

Applicants enclose herewith the Appeal Brief and two copies thereof for the above-entitled application, said brief being due **December 1, 2003**.

Please charge Deposit Account No. 14-0225 for the \$330.00 fee or any other fees associated with the filing of said Appeal Brief.

No oral hearing is requested.

Respectfully submitted,



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APPEAL BRIEF

Sir:

This Appeal Brief is in furtherance of the Notice of Appeal filed in this case on **October 1, 2003**. Three copies of the Appeal Brief are filed herewith. Authorization is given to charge deposit account number 14-0225 for the fee under 37 C.F.R. 1.17 for filing the Appeal Brief.

(1) REAL PARTY IN INTEREST

The present application is assigned to NCR Corporation of Maryland.

(2) RELATED APPEALS AND INTERFERENCES

None.

(3) STATUS OF ALL CLAIMS

The above-identified patent application was filed on June 21, 1999 with claims 1-19. A Preliminary Amendment was filed on November 30, 1999 in which claims 20-31 were added. In response to an Office Action mailed on March 15, 2002, claims 1-31 were canceled, and new claims 32-45 were added. In response to an Office Action mailed on September 24, 2002, claims 33-38, 43, and 44 were elected for further prosecution on the merits, and claims 32, 39-42, and 45 were withdrawn from consideration. In response to an Office Action mailed on January 28, 2003, claims 37 and 38 were canceled. In response to a final Office Action mailed on July 2, 2003, withdrawn claims 32, 39-42, and 45 were canceled. However, since the Examiner did not indicate in the Advisory Action of September 10, 2003 that the response to the final Office Action mailed on July 2, 2003 was entered, claims 32, 39-42, and 45 remain withdrawn from consideration. A Notice of Appeal was filed on October 1, 2003. Thus, claims 33-36, 43, and 44 stand rejected.

Claims 33-36, 43, and 44 are being appealed and are attached as an appendix to this Appeal Brief.

(4) STATUS OF ALL AMENDMENTS FILED SUBSEQUENT TO FINAL REJECTION

An amendment canceling claims 32, 39-42, and 45 was filed on August 1, 2003 subsequent to the final Office Action mailed on July 3, 2003. However, since the Examiner did not indicate in the Advisory Action of September 10, 2003 that the amendment of August 1, 2003 was entered, claims 32, 39-42, and 45 remain withdrawn from consideration.

(5) CONCISE SUMMARY OF THE INVENTION

A self-service terminal (terminal 10; see page 1, line 29 and page 2, lines 31-32 of the specification) allows a mobile telephone service user to purchase additional mobile telephone service time for a mobile telephone service account. The self-service terminal includes a first device (card reader 41; see page 3, line 4 and page 6, lines 5-7 of the specification) for

receiving account details of the mobile telephone service account from the mobile telephone service user. The self-service terminal also includes a second device (note acceptor 32; see page 3, lines 29-32) for receiving currency from the mobile telephone service user. The self-service terminal further includes a third device (control means 60; see page 3, lines 21-25 of the specification) for communicating with a remote information handling system (computer system of the telephone provider 90; see page 3, lines 21-25) to credit mobile telephone service time to the mobile telephone service account based upon account details of the mobile telephone service account received from the mobile telephone service user and the amount of currency received from the mobile telephone service user (see page 6, lines 1-11 of the specification).

(6) CONCISE STATEMENT OF ALL ISSUES PRESENTED FOR REVIEW

An issue presented for review is whether any of claims 33-36, 43, and 44 is patentable over "Billers benefit when the bill's not in the mail", Bank Network News, v15, n8, p4-5, Sep 11, 1996.

(7) GROUPING OF CLAIMS FOR EACH GROUND OF REJECTION WHICH APPLICANT CONTEST

Claims 33-36, 43, and 44 are grouped together.

(8) THE REJECTION

Claims 33-36, 43, and 44 are rejected under 35 U.S.C. §103(a) as being unpatentable over "Billers benefit when the bill's not in the mail", Bank Network News, v15, n8, p4-5, Sep 11, 1996.

(9) APPLICANT'S POSITION

Applicant believes that each of claims 33-36, 43, and 44 of the present application is patentable over the prior art including the prior art references of record. Applicant would like to respectfully point out that the rejection of claims 33-36, 43, and 44 is incorrect for the reasons explained hereinbelow.

Claims are directed to "purchasing additional time" not to "receiving payments"

The final Office Action states that each of claims 33-36, 43, and 44 is directed to "an automated terminal for receiving payments for a mobile telephone" or "a method of operating a self service terminal directed to receiving payments for a mobile telephone service".

However, this is incorrect. Instead, each of claims 33-36, 43, and 44 is directed to self-service terminals at which a user can purchase additional telephone service time for a telephone service account, and methods of operating such self-service terminals [Emphasis added by Applicant].

More specifically, each of claims 33-35 recites, inter alia, "A self-service terminal for enabling a telephone user to purchase additional telephone service time for a telephone service account", claim 36 recites, inter alia, "A self-service terminal for allowing a mobile telephone service user to purchase additional mobile telephone service time for a mobile telephone service account, claim 43 recites, inter alia, "A method of operating a self-service terminal for enabling a telephone user to purchase additional telephone service time for a telephone service account", and claim 44 recites, inter alia, "A method of operating a self-service terminal for allowing a mobile telephone service user to purchase additional mobile telephone service time for a mobile telephone service account". Support for each of claims 33-36, 43, and 44 is found on at least page 6, lines 1-17 of the specification.

The act of "purchasing additional time" is clearly different from the act of "receiving payments". The difference between "purchasing additional time" and "receiving payments" is not merely semantic, but is fundamental to the claimed invention. The act of purchasing additional time at a self-service terminal involves the terminal not only receiving payments, but also involves the terminal providing a novel function (i.e., enabling a self-service terminal user to purchase additional telephone service time, in the present case) which goes well beyond the terminal just receiving payments.

Prior art does not disclose or suggest "purchasing additional telephone service time"

Applicant would like to respectfully point out that none of the prior art including the article "Billers benefit when the bill's not in the mail" (referred to herein as "the Article") discloses or suggests "purchasing additional telephone service time" as recited in each of claims 33-36, 43, and 44 of the present application.

Prior art Article is irrelevant to the claims of the present invention

The Article relates to electronic bill presentment and payment of bills. None of claims 33-36, 43, and 44 of the present application relates to electronic bill presentment or payment of bills. In fact, in the claimed invention, no bill even exists when a user pays for additional telephone service time for a telephone service account at a self-service terminal, as explained further below.

Webster's dictionary defines "bill", inter alia, as "an itemized account of the separate cost of goods sold, services performed, or work done". Thus, a bill is provided before payment to indicate how much money is due for what has already been sold, performed, or done.

Accordingly, when a user pays a bill for a service at a self-service terminal, the user has already used the service, and the bill informs the user of the amount of money to be paid for the used service. Therefore, it is clear that when a user pays a bill at a self-service terminal, the payment is made for a service that was used up by the user in the past.

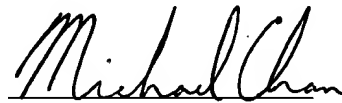
However, when a user pays for additional telephone service time for a telephone service account at a self-service terminal, as in the claimed invention, no bill can exist because the purchased additional telephone service time has not yet been used up by the user. The purchased additional telephone service time is for use by the user in the future. Since the purchased additional telephone service time will not be used up by the user until after payment has been made, no bill can exist. Thus, the prior art Article is irrelevant to the claims of the present invention.

Applicant has respectfully requested that the Examiner identify where the Article discloses or suggests self-service terminals at which a user can purchase additional telephone service time for a telephone service account, and methods of operating such self-service terminals. Also, Applicant has respectfully requested that the Examiner explain in detail how the act of a user at a self-service terminal purchasing additional telephone time for a telephone service account is the same as the act of a user at a self-service terminal paying a bill. However, the Examiner has not provided any explanations. Accordingly, it is respectfully submitted the rejection of the claims of the present application is improper and, therefore, should be withdrawn.

(10) CONCLUSION

In view of the forgoing reasons, it is clear that the rejection of claims 33-36, 43, and 44 under 35 U.S.C. Section 103(a) is improper and, therefore, should be withdrawn. It is respectfully requested that the Board reverse the rejection of claims 33-36, 43, and 44.

Respectfully submitted,



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(11) APPENDIX

33. (previously presented): A self-service terminal for enabling a telephone user to purchase additional telephone service time for a telephone service account, the self-service terminal comprising:

input receiving means for receiving account details associated with a telephone service account from a telephone user;

payment receiving means for receiving payment from a telephone user to pay for purchase of additional telephone service time for a telephone service account; and

control means for communicating with a remote system to credit service time to a telephone service account identified by account details received from a telephone user when payment is received from the telephone user.

34. (previously presented): A self-service terminal according to claim 33, wherein the payment receiving means includes means for receiving payment in the form of currency.

35. (previously presented): A self-service terminal according to claim 33, wherein the payment receiving means includes means for receiving payment in the form of credit.

36. (previously presented): A self-service terminal for allowing a mobile telephone service user to purchase additional mobile telephone service time for a mobile telephone service account, the self-service terminal comprising:

a first device for receiving account details of the mobile telephone service account from the mobile telephone service user;

a second device for receiving currency from the mobile telephone service user;
and

a third device for communicating with a remote information handling system to credit mobile telephone service time to the mobile telephone service account based upon

account details of the mobile telephone service account received from the mobile telephone service user and the amount of currency received from the mobile telephone service user.

43. (previously presented): A method of operating a self-service terminal for enabling a telephone user to purchase additional telephone service time for a telephone service account, the method comprising:

receiving account details associated with a telephone service account from a telephone user;

receiving payment from a telephone user to pay for purchase of additional telephone service time for a telephone service account; and

communicating with a remote system to credit service time to a telephone service account identified by account details received from a telephone user when payment is received from the telephone user.

44. (previously presented): A method of operating a self-service terminal for allowing a mobile telephone service user to purchase additional mobile telephone service time for a mobile telephone service account, the method comprising:

receiving account details of the mobile telephone service account from the mobile telephone service user;

receiving currency from the mobile telephone service user; and

communicating with a remote information handling system to credit mobile telephone service time to the mobile telephone service account based upon account details of the mobile telephone service account received from the mobile telephone service user and the amount of currency received from the mobile telephone service user.